

### **REMARKS**

Claim 129 has been rejected as indefinite under § 112 with respect to the use of the term “non-monetary”. “Monetary” is ordinarily defined as “relating to money.” The term has been present in the Claims since the case was filed (see, e.g., Claim 2, which language was incorporated into Claim 1 thereafter in August 2003). After countless Office Actions by the many Examiners who have reviewed these Claims, no one has ever objected before. Examiner Omotosho has, in fact, previously referenced the term in the context of the prior art, without any question as to its meaning (see, e.g., Office Action of February 2, 2007, p. 6), as have his predecessor Examiners (e.g., Ex. Mosser, Office Action of June 16, 2006, p. 7). It is therefore submitted that the term is well-defined in this application, and has a well-understood ordinary meaning. This rejection should be withdrawn.

The pending Claims have all been rejected under § 102(e) on Byrne publication US2005/14553, published January 20, 2005, with a filing date of August 19, 2004 (USSN 10/922,535) (“Byrne ’535”). First, Byrne ’535 is not statutory prior art, because Applicants have a filing date of January 18, 2002, which is well over two years before the Byrne ’535 filing date.

The filing date of Byrne ’535 is very significant. Applicants found it highly unusual that the Examiner was relying on the language in *Claims* 37 and 39 of Byrne for the basis of the rejection. As will be discussed further below, there is no support in the specification of Byrne for these claims. From what Applicants have been able to determine, this language in these claims appeared *for the first time* in Byrne ’535.

The '535 publication is listed as a continuation of an application published as U.S. Patent Application Publication 2003/0027618 (the '618 publication), which in turn is listed as a continuation of the application that resulted in U.S. Patent 6,425,823 (the '823 patent). The '823 patent is a continuation of the application that resulted in U.S. Patent 6,336,862 (the '862 patent). The '862 patent is a continuation of the application that resulted in U.S. Patent 5,830,063 (the '063 patent). A timeline representing the filing and publication dates is presented below:

January 20, 2005:	The '535 publication is published.
August 19, 2004:	The '535 application is filed.
August 21, 2003:	Applicants' instant application is published as US 2003/0157977.
February 6, 2003:	The '618 publication is published.
July 30, 2002:	Date of the '823 patent.
June 24, 2002:	The application underlying the '618 publication is filed.
January 18, 2002:	Applicants' instant application is filed.
January 8, 2002:	Date of the '862 patent.
October 18, 2000:	The application underlying the '823 patent is filed.
November 3, 1998:	Date of the '063 patent.
October 15, 1997:	The application underlying the '862 patent is filed.
March 6, 1996:	§ 102(e) date listed on face of the '063 patent.

Byrne '823 patent, the '862 patent, and the '063 patent all fail to include the language found in Claim 37 (as representative) of Byrne '535. Applicants have furthermore reviewed all of the publicly electronically accessible file history records for the Byrne predecessor cases, and do not find this language appearing in any of the claims therein. Consequently, the first published appearance of the language found in Claim 37 of the Byrne '535

publication cited by the Examiner appears to be the '535 application, which was filed nearly one year after the *publication* of Applicants' application.

In short, the language relied upon by the Examiner was new matter to Byrne '535. Resort to the dates of the continuations in the chain is of no avail. Moreover, based upon the timing of the first appearance of this language, it would seem that Byrne saw Applicants' patent publication, and then filed Byrne '535 with this language in an attempt to capture what Applicants have invented.

As noted above, the rest of the specification of Byrne '535 does not disclose Applicants' invention. Besides the aforementioned Claims 37 and 39, the Examiner only cites to ¶¶ 42 and 44 of Byrne. Yet the games described relate to the award of the second game being wholly dependent upon a winning outcome in the first game of chance -- someone has to win the "standard Keno" game to establish eligibility for a share in the "Super Keno" game. Moreover, a separate wager has to be placed for the "Super Keno" opportunity. Quite simply, Byrne has no disclosure of a wagering gaming machine that has a separate game of chance which operates independently and irrespectively of the outcome in an underlying base game, and (Cls. 112 and 113) has a card game for the base game with the second game indicia in like number to the cards with the indicia potentially yielding an award on every play thereof, or (Cl. 114) has reels instead of cards for the base game, or (Cl. 129) has reels for the base game and indicia for the second game which when matched yield a prize that is not money.

The Examiner has also now rejected the Claims under § 102(b) on Marnell US 5,393,057. Yet this is not a "newly discovered" reference, as the Office Action indicates!

It was cited by the Examiner (Robert Mosser) in the Office Action dated June 16, 2006. That Examiner particularly applied the disclosure of predecessor Marnell US 5,332,219 against the Claims. Claims 112 and 113 were found allowable over all of this Marnell art over 18 months ago.

Marnell '057 is no more relevant as prior art than Marnell '219. It discloses an underlying poker or slot machine game that is linked to a bingo game "in a manner enabling play of the bingo gaming device *only upon the occurrence of winning* hands in the poker gaming device or winning reel combinations in the slot machine." (3/35-41, emphasis added).

Applicants' invention is fundamentally different, because the second game outcome is assessed irrespective of the outcome of the underlying base game -- they are not tied together, and the second game is independent of the first game. Marnell relies upon "selected events" occurring in the base game to trigger the second game -- which is no more than a bonus game that is triggered by some event in the base game. No such "event" is requisite for Applicants' Claims, and that is a very distinguishing feature from the prior art.

The Examiner has also rejected the "non-monetary" limitation in certain of the pending Claims on the basis of Marnell 5/50-60; there is no such disclosure there, however.

It is also herein made of record that the Interview Summary mailed October 16, 2007 has an error. It reads "Applicant noted [pending claims] are rejectable in light of new art [Byrne]." In fact, it was the Examiner who made this statement; Applicants' representative did not even have a copy of the reference in point at that time, since the Examiner brought it up for the first time in the telephone conference.

Applicants have shown that the Claims are all allowable over the cited art. A Notice of Allowance is requested; respectfully, it is long overdue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "M. Baniak", written over a horizontal line.

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